

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 12, 14-22, 29, and 30 are presently active in this case. Claims 1-11, 13, 23-28, and 31-37 were previously canceled without prejudice or disclaimer.

The outstanding Office Action rejects Claims 12, 14-22, 29, and 30 under the first paragraph of 35 U.S.C. §112 as being based on a non-enabling disclosure; rejects Claims 12, 14, 15, 17, 21, 22, 29, and 30 under 35 U.S.C. §103(a) as unpatentable over Bauer, II (U.S. Patent No. 3,692,394, herein "Bauer") in view of Ohshima et al. (U.S. Patent No. 4,821,911, herein "Oshima") and Glenn (U.S. Patent No. 4,667,226) in further view of Hines (U.S. Patent No. 6,122,455); rejects Claims 16, 18, and 19 under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Glenn, and Hines, and in further view of Okada et al. (U.S. Patent No. 4,758,905, herein "Okada"); and rejects Claim 20 under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Glenn, and Hines, and in further view of Anderson (U.S. Patent No. 6,215,523).

The rejection of Claims 12, 14-22, 29, and 30 under 35 U.S.C. §112, first paragraph, as being based on a non-enabling disclosure is again traversed. The PTO has clearly misinterpreted the disclosure of FIG. 1 and the language of Claims 12, 14-22, 29, and 30 as suggesting that the internal construction of the viewfinder is "critical." This is not the case as the relevant arguments noted at page 2 of the outstanding Action are arguments directed to limitations requiring that the closed shutter directs "light to a light receiving portion of the viewfinder **along an optical path leading to the light receiving portion of the viewfinder.**" The optical path recited is from the shutter in closed condition "**to the light receiving portion of the viewfinder**" and cannot be reasonably interpreted as being an optical path inside the viewfinder.

The bottom of page 2 outstanding Action suggests that “**IF** the camera in Bauer were to be drawn without the specifics of the viewfinder, one could easily draw a box, as applicant has done in their disclosure, to represent the prism (24) and the viewfinder (26) to be included in the box representing the viewfinder” (emphasis added). The simple answer to this hypothetical rationale is that Bauer has drawn no such box and this hypothetical box is a suggestion of the PTO, not of Bauer. It is well settled that the PTO cannot expand reference teachings using unfounded assumptions and/or speculation. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”). Thus, the “examiner’s opinion that the details of the viewfinder must be critical to the applicant’s invention” is based upon a speculative/hypothetical modification to the actual disclosed camera of Bauer that is clearly an improper PTO attempt to insert its own teachings into Bauer and then interpret them to be the actual teachings of Bauer.

The top of page 3 of the outstanding Action asserts a further speculative/hypothetical position that if the viewfinder of applicant’s were to include a prism, this would somehow compensate for the lack of any disclosure in Bauer of a box that is drawn around elements 24 and 26 or a written description suggesting that these elements (24 and 26) together are what constitute a “viewfinder.” Again, Bauer teaches what Bauer teaches, not what the PTO would like to modify Bauer to teach based upon speculative assumptions. The simple fact is that the optical path **outside of** and leading to the viewfinder is what is claimed and shown by FIG. 1, not any path inside the disclosed viewfinder. Making speculative assumptions as to how the disclosure of Bauer might be modified does not change what the claim language specifies. Thus, the PTO has once more failed to establish a *prima facie* case based upon

hypothetical what “if” speculation and withdrawal of this clearly erroneous rejection is again submitted to be in order.

Turning to the rejection of Claims 12, 14, 15, 17, 21, 22, 29, and 30 under 35 U.S.C. §103(a) as unpatentable over Bauer in view of Ohshima, Glenn, and further in view of Hines, this rejection is traversed as lacking establishment of any reasonable *prima facie* case of obviousness because none of these applied references teach all of the subject matter of independent base Claims 14 and 22. In this regard, Claim 14 requires the claimed shutter element “to direct the light to a light receiving portion of the viewfinder along an optical path leading to the light receiving portion of the viewfinder, in a closed position, without further change of the optical path leading to the light receiving portion of the viewfinder.” A similar requirement appears in Claim 22 shutter means recital (“ shutter means for directing the light passing along the main optical axis directly to a light receiving portion of the viewfinder means along an optical path leading to the light receiving portion of the viewfinder means in a closed position of the shutter means and for passing the light to the photoelectric-effect means in an open position of the shutter means, thereby providing the vision over a wide field to a user during imaging without further change of the optical path leading to the light receiving portion of the viewfinder means”).

Bauer is again relied upon by the outstanding Office Action as a primary reference relied upon in each of the above noted 35 U.S.C. §103(a) rejections. However, Bauer describes a motion picture film camera, where the light from the scene being viewed is reflected by the forward surface 22 of rotating shutter 16 to the reflecting prism 24 that redirects this light to the viewfinder lens system 26 having eyepiece 28. See Bauer at col. 2, lines 4-10. As illustrated in Bauer’s Figure 1, the optical path is deflected twice, first by the forward surface 22 of rotary reflective shutter 16 and then by the reflecting prism 24 to get to the eyepiece 28 through the lens system 26. The reflecting prism 24 is clearly described and

shown by Bauer to be a separate element from the eyepiece 28 that is shown integral with lens system 26.

As note above, the PTO employs improper speculative assumptions instead of any factual evidence to reach the unsupported conclusion that “[c]learly the prism (24) of Bauer is part of the optical viewfinder.” As noted in the last response, this PTO conclusion must be based on actual teachings found in Bauer, not speculative expansions of those actual reference teachings. See again *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Bauer teaches that a separate reflecting prism element 24 is provided inside a camera body housing 12 to alter the light path from reflecting surface 22 of shutter 16 so it can be directed into the light receiving portion of the lens system 26. To the extent that the PTO is basing its assertion that this separate reflecting prism element 24 is part of the viewfinder because it inputs light to the lens system 26 and is adjacent thereto, then the shutter 16 shown adjacent to the prism 24 and directing light thereto must also be interpreted to be a part of the viewfinder and not the claimed separate shutter that directs light to the viewfinder. Similarly, the lens 14 adjacent to the shutter 16 that directs light to this shutter also must be part of the viewfinder based upon the logic apparently adopted by the PTO. Clearly, this attempt to interpret the separate reflecting prism element 24 as somehow taught to be integral with the lens system 26 defies logic and is based upon speculation not evidence.

Such reliance on speculation to make arbitrary findings is contrary to established case law requiring the PTO to present factual evidence. See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (“With respect to core factual findings in a determination of patentability, however, the [PTO] . . . must point to some concrete evidence in the record in support of these findings.”); *In re Lee*, 277 F.3d at 1343-44, 61 USPQ2d at 1434 (This factual question . . . material to patentability [cannot] be resolved on subjective

belief and unknown authority.”). Thus the burden is on the PTO to produce concrete evidence in support of its findings, not the mere speculation of item 4 on page 4 of the outstanding Action that “[i]f the camera in Braun were to be drawn without the specifics of the viewfinder, one could easily draw a box, as applicant has done in their disclosure, to represent the prism (24) and viewfinder (26) to be included in the box representing the viewfinder.”

In this regard, Fig. 1 of Braun exists and it shows that reflecting prism 24 is a separate element contained in the camera housing 12. The lens system 26 is further clearly shown to be separated from the reflecting prism 24 and to be attached with eyepiece 28 to the camera housing 12 as a separate unit. PTO speculation as to what might be drawn if this Fig. 1 showing were not presented is not the required “concrete evidence in the record.” Note the following from *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984)

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under section 103. As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the “burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103.”

In addition, the relied upon teachings of Hines clearly demonstrate that a “viewfinder” is a lens system like 26 of Bauer. Therefore, it is submitted that as there is no concrete evidence of record and, thus, no factual basis to support the arbitrary conclusion presented by the outstanding Action that reflecting prism 24 is taught to be part of the Bauer “viewfinder” lens system 26. Accordingly, Bauer *fails to teach or suggest* a shutter configured to direct the light to the viewfinder without further change of the optical path leading to the light receiving portion of the viewfinder.

This approach of interpreting teachings into the references is continued as to the reasons offered in the outstanding Action why the artisan would have modified Bauer based on Oshima. In this regard, the outstanding Action urges that the artisan would have been led by Oshima to first convert the Bauer motion picture film camera to a video camera so that it

could “capture digital images in studio quality” as noted in the sentence bridging pages 7 and 8. Once again the PTO improperly injects its teachings to supplement the actual teachings of Oshima who teaches no “capture of digital images,” much less any particular image quality. *See In re Rijckaert*, 9 F. 3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”).

Moreover, more than a simple conversion from a motion picture camera to a video camera is being suggested as the artisan is not simply urged to just replace the film and film gate of Bauer with a single video image sensor like 23 of the relied on Okada reference. Instead, the adoption of the much more complex spatial splitter optics and separate sensors of Oshima are urged to be required based on the PTO speculation as to capturing “digital images.” This situation is strikingly similar to the PTO hindsight approach criticized by the Court in *In re Lee*, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) as lacking any evidentiary support and satisfactory explanation as follows:

Deferential judicial review under the Administrative Procedure Act does not relieve the agency of its obligation to develop an evidentiary basis for its findings. To the contrary, the Administrative Procedure Act reinforces this objection. *See, e.g., Motor Vehicle Manufacturers Ass’n v. State Farm Mutual Automobile Ins. Co.*, 463 U.S. 29, 43 (1983) (“the agency must examine the relevant data and articulate a satisfactory explanation for its action including a ‘rational connection between the facts found and the choice made.’”)

Moreover, this is not the only alteration required that will change the intended operation of the Bauer motion picture camera based upon the requirements of independent Claims 14 and 22 as to the rotational speed control and associated position sensor. In this regard, it is clear that Bauer teaches an operation for a motion picture camera that requires the shutter to be driven “at constant speed when the camera is operating, and to automatically stop the shutter in one of its blocking positions.” *See* col. 2, lines 21-24 of Bauer. Thus, Bauer teaches using a conventional crystal oscillator motor speed control circuit 52 to

provide the required “precise control of the speed of the motor 40.” See col. 2, lines 48-56 of Bauer. The stopping operation required by Bauer is a more complex affair requiring the deceleration control noted at col. 2, line 57 to col. 6, line 25 and the automatic turnoff noted at col. 6, line 26 to col. col. 7, line 30.

These express requirements in Bauer for providing the motion picture camera motor control to include shutter rotational speed control, deceleration control and automatic turnoff notwithstanding, the PTO urges the artisan would have been led to not only convert the camera from motion picture filming to video imaging with the Oshina spatial splitter optics and separate sensors, they would also find the scraping of the Bauer motion picture shutter motor control circuitry to be obvious in view of Glenn.

However, the rationale in the outstanding rejection applied as to the subject matter of independent Claims 14 and 22 being in part taught by Glen once again ignores the fact that the rotating shutter 101 of Glen is taught to be between two video cameras 130 and 140 that have different scan rates and not between even one camera and an element that will provide a reflected portion to a view finder having no scan rate.

The bottom of page 3 of the outstanding Action attempts to remedy this deficiency by creating a broader teaching that ignores the actual context of the teachings of Glen itself. This PTO modification of the actual teachings of Glen is the assertion that this reference teaches “driving a rotating shutter for redirecting light to a different location at a speed of rotation proportional to the frequency of a synchronization signal for the reading of the sensors by a processing means.”

In determining the scope and content of the teachings and suggestions of Glen, the PTO analysis must comport to the precedent of the U.S. Court of Appeals for the Federal Circuit as to properly interpreting the teachings of the prior art references. See *In re Lee* 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“As discussed in *National Labor*

Relations Bd. v. Ashkenazy Property Mgt. Corp., 817 F.2d 74, 75 (9th Cir. 1987), an agency is 'not free to refuse to follow circuit precedent.'"). The relevant Federal Circuit precedent requires that "[reference] statements cannot be viewed in the abstract" because reference teachings must be determined based on "the context of the teaching of the entire reference." See *In re Kotzab* 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). This is a well established precedent, further note *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) requiring "a fair reading of the prior art reference as a whole," and *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965) warning the PTO that "it is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." The rationale noted above asserting the PTO interpretation of Glen translates to exactly such prohibited picking and choosing married with the further prohibited viewing of the Glen teachings "in the abstract" outside "the context of the teaching of the entire reference."

Furthermore, the reliance on Ohshima and Glenn to suggest the complete reconstruction and redesign of the mechanical, electrical, and optical elements of Bauer is contrary to established precedent. See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA (CCPA 1959) reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle" under which the basic reference was designed to operate.

The rationale offered in the outstanding Action translates into little more than suggesting that various subcombinations forming the claimed combination were known in the art as parts of unrelated combinations with other elements. This rationale cannot be used to

establish a valid *prima facie* case of obviousness, see *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) as follows:

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

Furthermore, none of the secondary references (Ohshima, Glenn, Hines, Okada, and/or Anderson) cure this deficiency of Bauer such that the PTO has failed to carry its burden of demonstrating that each and every limitation claimed is taught by the prior art relied on in the rejections noted above. Accordingly, as no *prima facie* case of obviousness has been established, the withdrawal of the rejection of Claims 12, 14, 15, 17, 21, 22, 29, and 30 under 35 U.S.C. §103(a) as unpatentable over Bauer in view of Ohshima and Glenn further in view of Hines, the rejection of Claims 16, 18, and 19 under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Glenn, Hines, in further view of Okada, and the rejection of Claim 20 under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Glenn, and Hines, in further view of Anderson is respectfully submitted to be in order.

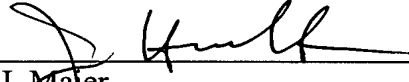
In addition, it is believed to be clear that the feature added by Claim 20 ("a screen configured to display the synthesis of the light components after passage into processing means") is not taught or suggested by any of the references being relied upon. Accordingly, Claim 20 is further submitted to be patentable for this reason as well.

Consequently, in view of the present amendment and traversals, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance.

Should the Examiner believe that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

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